

A2 25. A method for including a lactose-converting active to a lactose-containing composition, and thereby converting at least some of the lactose in the lactose-containing composition to another substance, the method comprising the steps of including the lactose-converting active in the lactose-containing while the composition is at or above a temperature that would denature the active.

A3 42. A device for imparting a beneficial effect to a composition, the device comprising an active, and a material covering or coating at least part of the active, the device for being used in a composition while the composition is at or above a temperature that would denature the active, the device designed to dissolve slowly enough in the composition at or above the temperature that would denature the active in order to prevent at least some of the active from being denatured, thus enabling the active to impart a beneficial effect to the composition.

Appendix A includes the claims showing the changes made thereto.

II. REMARKS.

A. Rejections Under 35 U.S.C. § 112.

In view of the deletion of claim 1, the Examiner's comment regarding the use of "such as" is believed to be traversed. This deletion is not meant to limit the scope of any of the limitations of the remaining claims.

Applicant respectfully disagrees with the Examiner's position that the terms "a temperature capable of denaturing the active," "slowly enough," "an active" and "another substance" render the claims indefinite.

First, the terms “active,” “denaturing temperature,” and “beneficial effect” are defined in the specification at page 1, lines 11-23. Additionally, persons skilled in the art understand what these terms mean and the Examiner has not provided any objective evidence to the contrary.

Second, Applicant frankly does not understand the Examiner’s position with respect to the use of the term “another substance” in claim 25. The claim language is clear and unambiguous on its face – it means that at least some of the lactose is converted into a substance other than lactose.

Finally, with respect to the term “slowly enough,” it is relative and depends on the active used and the temperature of the composition, but the term is clear on its face, uses simple English words and would readily be understood by those skilled in the art. Breadth of a claim is not a legitimate ground for arguing that the claim is indefinite. In re Borkowski, 164 USPQ 642, 645-46 (CCPA 1970); In re Gardner, 166 USPQ 138, 140 (CCPA 1970).

B. Rejections Under 35 U.S.C. § 103.

The Examiner uses Monte 5,707,843 as the primary reference for the rejection under 35 U.S.C. § 103. However, neither Monte nor any of the references of record teach, among other things, including an active, or a device comprising an active, in a composition while the composition is at a temperature that would denature the active, as is recited in the amended claims. The present Specification generally explains some of the prior art processes (page 1, l. 24 – page 5, l. 15) and some of the benefits of the present invention (page 7, l. 15 – page 8, l. 22), which explain to a large extent the nonobviousness of the claimed invention.

For this reason the rejection under 35 U.S.C. § 103 is traversed because (1) the proposed combinations do not include each and every limitation of the pending claims, and (2) there is no suggestion or motivation in the prior art to supply the missing limitations.

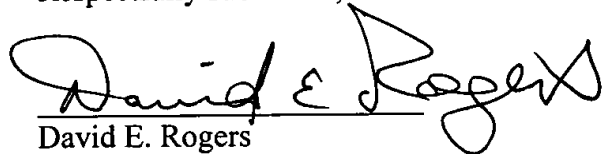
Applicant reserves the right to proffer other arguments, including lack of motivation to combine, other missing limitations of any proposed combination and objective indicia of nonobviousness in the future.

III. CONCLUSION.

For the foregoing reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejections under 35 U.S.C. §§ 103 and 112 and to allow the instant claims. If any concerns remain or arise which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to **Deposit Account No. 19-3878**. Applicant further reserves the right to prosecute additional and broader claims in a continuation application.

Respectfully submitted,



David E. Rogers
Registration No. 38,287

SQUIRE, SANDERS & DEMPSEY, LLP.
Two Renaissance Square
40 North Central Ave., Suite 2700
Phoenix, Arizona 85004
Telephone: (602) 528-4122
Facsimile: (602) 253-8129

Appendix A

Please delete claim 1.

2. (Amended) A method for [adding] including a device, wherein the device includes [containing] an active, [to] in a food or cosmetic composition, the method [including the steps of:] comprising including the device in the composition while the temperature that would denature the active

[(a) heating a composition to or above a temperature capable of denaturing the active; and

(b) adding the device to the composition].

whereby the device dissolves slowly enough in the composition so that at least some of the active is not denatured and imparts a beneficial effect to the composition.

25. (Amended) A method for [adding] including a lactose-converting active to a lactose-containing composition, and thereby converting at least some of the lactose in the lactose-containing composition to another substance, the method comprising [the steps of:] including the lactose-converting active in the lactose-containing composition while the composition is at or above a temperature that would denature the active.

[(a) heating the lactose-containing composition to or above a temperature that would destroy or denature the active; and

(b) adding a device including the lactose-converting active to the lactose-containing composition, the device temporarily preventing at least some of the lactose-converting active from coming into direct contact with the lactose-containing composition, in

order to enable at least some lactose-converting active to not be denatured and convert some of the lactose to another substance].

42. A device for imparting a beneficial effect to a composition, the device comprising an active, and a material covering or coating at least part of the active, the device for being used in a composition while the composition is at that [is heated to] or above a temperature that would denature the active, the device designed to dissolve [dissolving] slowly enough in the composition at or above the temperature that would denature the active in order to prevent at least some of the active from being denatured, thus enabling the active to impart a beneficial effect to the composition.